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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,196	08/23/2001	Yutaka Takahashi	100725-00051	8768
4372 7590 04/18/2007 ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER NGUYEN, TAN D	
			ART UNIT 3629	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/935,196	Applicant(s) TAKAHASHI ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 1/4/07 has been entered. Claims 1-9 (system) are pending.

As of 1/4/07, amended independent system claim 1 is as followed:

1. (Currently Amended) A marketing support system for allowing a supplier, which manufactures and sells to at least one sales agency a mechanical component having a rolling element and a sliding bearing, to support the at least one sales agency selling said mechanical component to a purchaser, comprising:

(a) a communication device of the supplier is-connected to an open network and comprising:

(a₁) technical information service means for providing technical information required to the purchaser for enabling the purchaser to select said mechanical component; and

(a₂) sales agency introduction means for introducing the at least one sales agency selling said mechanical component to the purchaser, and

(b) a communication device of the at least one sales agency connected to the open network and comprising:

(b₁) order processing means for taking an order from the purchaser to purchase the mechanical component and for electronically processing the purchase order, and

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(b₂) selection and purchasing means for the purchaser to access the communication device of the supplier over the open network and to select and purchase the mechanical component from one of the at least one sales agency.

Note: for convenience, letters are added to the beginning of each elements and sub-elements.

Claim Objections

2. Claims 2-4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 calls for a communication of the at least 1 sales agency (reads over 1 agency). Claim 2 calls for "select a responsible sales agency from the at least one sales agency" is vague since there is only 1 agency and no selection of a "responsible" sales agency can be made since there are no option with 1 agency. The limitation of dep. claims 2-3 can only work if claim 1 is modified to include "several sales agencies". Furthermore, it appears in element (b₂) above, the selection and purchasing means for the purchase appears to have 2 functions: (1) select and (2) purchase the mechanical components at the communication device (b) of the at least one sales agency. It's not clear whether (or improper) for the element means for (b₂) above to have additional function, i.e. selecting a responsible sales agency, outside of the "means for" function claim.

Claim Rejections - 35 USC § 112

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the 2nd element,

(b) a communication device of the at least one sales agency comprising:

(b₁) order processing means and

(b₂) selection and purchasing means for the purchaser to access the communication device of the supplier over the open network and to select and purchase the mechanical component from one of the at least one sales agency" is vague and indefinite. As shown in the "means plus function" limitation, "selection and purchasing means" and under "a communication device of the at least one sales agency", it's not clear how the purchaser can access the communication device of the supplier over the open network when the (b₂) device is only for selection and purchasing the mechanical component from one of the at least one sales agency only.

Similarly, dep. claim 3 is rejected for the same reason set forth in claim 1 above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1-9 are rejected under 35 U.S.C. 103(a) as obvious over VOROBIEV (US patent 6,651,063).**

As for independent system (apparatus) claim 1, in a similar system for marketing support system {see Fig. 1 (10)}, **VOROBIEV** discloses a system for interactive communication of seamless distribution of reliable organized information among suppliers, manufactures, retailers (sales agents) and customers {see col. 15, lines 52-55}, comprising:

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(a) a communication device of the supplier is connected to an open network (Internet) and comprises {see Fig. 4, 310, (314)}:

(a₁) technical information service means for providing technical information required to the purchaser

{see col. 4, line 67 to col. 5, line 5 "... information a Provider or Manufacturer (supplier) may furnish to Recipients", or col. 10, lines 30-41 "... desirable to send information to users that is not generated by the Providers 14, such as retailers or service providers,, but rather,, the original source of the goods such as a Manufacturer 42 (supplier) .."; and col. 14, lines 2-60, ". visitor 212 may request information about ... products", Fig. 1. (14, 18, 42), Fig. 4, 320};

(a₂) sales agency introduction means for introducing the at least one sales agency selling said mechanical component {see Fig. 4, 322A "DYNAMIC INFORMATION, (ORDERING, SHIPPING), col. 17, lines 1-43, especially lines 30-38 "... can include integral links to information from the car manufacturer's various relevant }, and

(b) a communication device of the at least one sales agency is connected to the open network and comprises {SEE Fig. 5, (414), (422)}

(b₁) order processing means for taking information (order) from the purchaser to purchase the mechanical component and for electronically processing the purchase order {see Fig. 4, 322A "DYNAMIC INFORMATION, (ORDERING, SHIPPING), col. 16, lines 1-65, col. 17, 1-37} and

(b₂) selection and purchasing means for the purchaser to access the communication device of the supplier over the open network and to select and purchase the mechanical component from one of the at least one sales agency.

{see Fig. 4, 322A, col. 16, lines 1-22, lines 57-60 "... a customer 412 who has a valid User Destination Address buys an automobile model ABC from a car dealer 414 ..."}.

Note as shown in col. 4, lines 67 to col. 5, line 5, col. 10, lines 30-67, col. 11, lines 45-52, and col. 17, lines 37, and Figs. 1, 4 and 5, VOROBIEV teaches interactive communication steps between the manufacturer (supplier) and to either (1) the provider (sales agency or retailer) or (2) the customer (recipient or purchaser) on the Internet through the use of the Dynamic Information Pack (Fig. 4, 322A) whereby the customer can order the item by selecting and purchasing the item at the provider's location (sales agency or retailer). When the Dynamic Information Pack originated from the manufacturer and goes through the Sales agency before routing to the customer, it allows the Sales agency to supplement or modify the information Pack with its own specific information (static information such as name, address, or drug information) {see col. 11, lines 50-11}. Alternatively, it would have been obvious to have interactive communication between the manufacturer (supplier) and the customer (purchaser) using the Dynamic Information Pack if the modifying or supplementing of the information Pack by the Sales agency (retailer) is not necessary.

VOROBIEV also teaches a web address link on the Manufacturer's Dynamic Information Pack to the retailer (sales agency) or relevant vendors {see col. 17} so that

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business-to-customer transaction can take place or integrated effectively with the business-to-business transaction {see col. 15, lines 50-55, col. 16, lines 57-60 "dealer-to-customer transaction"}. Alternatively, it would have been obvious to set up dealer to customer transaction on the Dynamic Information Pack to provide effective integration of marketing support and sales by the manufacturer.

Alternatively, the selection of any other type of mechanical component or the type of the mechanical component, which is non-essential to the scope of the claimed invention which is applicable to any tool or mechanical component, is considered as selection of other similar/equivalent material using the same process to achieve similar results and would have been obvious to a skilled artisan. Note on column 20, lines 7-12, VOROBIEV discloses "... that many variations and equivalents are possible, and are extended to be within the scope of the claims".

Note that in a system/ apparatus (system) claim, only features of the apparatus that are recited either structurally (device) or functionally (means for ...) have patentable weight. See *In re Schreiber*, 128 F. 3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32. Manner of operating the device or intended use of the system does not differentiate apparatus claim from the prior art.

As for dep. claims 2-3 (part of 1 above), which deal with well known sales/purchase parameters, i.e. selecting a responsible sales agency, etc., these concepts are taught in col. 16, lines 1-22 or Figs. 4 and 5. Moreover, this limitation "to select a responsible sales agency" has no patentable weight in an apparatus claim. How does one define "responsible" in an apparatus claim.

As for dep. claims 4-5 (part of 1/3 above), which deal with further limitation of the supplier communication device, i.e. receiving information (inquiry) from the customer about a product, VOROBIEV teaches interactive communication and Feedback communication between various parties, see col. 4, lines 28-67, Example 2 as shown on col. 14, lines 2-25, 58-67, Fig. 3 (212) "REQUEST PRODUCT INFORMATION", "COMMUNICATE TO INFORMATION PROVIDERS", Figs. 4-5, Dynamic information, with the term "visitor" inherently means recipient or customer or purchaser.

Alternatively, it would have been obvious to replace the term visitor 212 in Example 2 as recipient or purchaser (412) of Fig. 5 as mere changing the name of the recipient or entity who communicates with the manufacturer or vendor and makes a purchase of the component which he/she requests information thereof.

Note that in dep. claim 4, the phrase "... , contents of the inquiry ... the appropriate sales agency processes the purchase order" and non descriptive functional and merely method steps having no elemental or functional structure, thus having no patentable weight in an apparatus claim.

Note that in dep. claim 5, the phrase "... and allowingto the purchaser" is merely method step, thus having no elemental or functional structure, and therefore have no patentable weight in an apparatus claim.

As for dep. claim 6 (part of 1 above), which deal with well known features of the sales agency introduction means (dealer), i.e. name, item, address of the sales agency (dealer), etc., these are taught in Fig. 5, (424) "*Name of dealership, address, phone*".

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As for dep. claim 7 (part of 1 above), which deal with method step for doing thing and do not have either structurally elements (device) or functionally (means for) elements, they have no patentable weight in an apparatus claim. Moreover, this is well known or conventional practice and would have been obvious to do so and/or is inherently included in the teachings of VOROBIEV as indicated in Fig. 4, (322A "shipping, account balance).

As for dep. claims 8-9 (part of 1 above), which deal with well known purchasing parameters, i.e. credit/background check, approval, etc., these features are fairly taught col. 3, lines 10-60, col. 9, lines 1-10.

In summary, on col. 20, lines 7-12, or last paragraph, VOROBIEV discloses that its invention has been disclosed with respect to certain preferred embodiments and particular examples, those skilled in the art (such as the inventors), will recognize that the invention can be practiced with modifications or variations and equivalents (i.e. types of requesting information or components, communication between entities, etc. to meet certain specific conditions), as shown in dependent claims 2, or 3 or 4) and are intended within the spirit and scope of the claims (or are obvious), without objective secondary evidence (see 103 obvious tests on paragraph 4, item 4). No objective secondary evidence has been shown.

Response to Arguments

8. Applicant's arguments filed 1/4/07 have been fully considered but they are not persuasive.

(1) this is a system or apparatus claims, so there are a lot of non-functional descriptive materials as mentioned above, which have no patentable weight in an apparatus claim.

(2) Applicant's comment that VOROBIEV fails to teach element (a_1) is not persuasive in view of the description of the teachings of (a_1) cited in paragraph 6 above. Note that VOROBIEV discloses several alternatives for interactive communication between the supplier (manufacturer), retailer (sales agency) and the customer and the supplier can communicate directly to either the retailer or the customer. Note as shown in col. 4, lines 67 to col. 5, line 5, col. 10, lines 30-67, col. 11, lines 45-52, and col. 17, lines 37, and Figs. 1, 4 and 5, VOROBIEV teaches interactive communication steps between the manufacturer (supplier) and to either (1) the provider (sales agency or retailer) or (2) the customer (recipient or purchaser) on the Internet through the use of the Dynamic Information Pack (Fig. 4, 322A) whereby the customer can order the item by selecting and purchasing the item at the provider's location (sales agency or retailer). When the Dynamic Information Pack originated from the manufacturer and goes through the Sales agency before routing to the customer, it allows the Sales agency to supplement or modify the information Pack with its own specific information (static information such as name, address, or drug information) {see col. 11, lines 50-11}. Alternatively, it would have been obvious to have interactive communication between

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the manufacturer (supplier) and the customer (purchaser) using the Dynamic Information Pack if the modifying or supplementing of the information Pack by the Sales agency (retailer) is not necessary.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

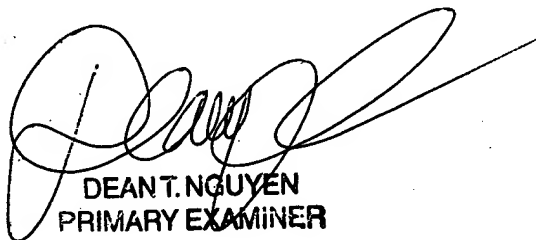
In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
April 2, 2007



DEAN T. NGUYEN
PRIMARY EXAMINER